

Accordingly, since the lining 43 of WO '372 is not in its uncompressed state, claim 1 is not anticipated by WO '372.

B. Claims 1, 5 and 6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over WO '372 in view of Official Notice. For the same reason, discussed above that WO '372 does not anticipate claim 1, i.e., that lining 43 is not in its uncompressed state, so, too, WO '372, when modified as proposed by the Examiner, does not render claims 1, 5 and 6 unpatentable.

C. Claims 1, 5 and 6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over White 3,805,413 or Adams 4,102,062 in view of WO '372.

(i) White

Applicant's invention is directed to a boot in which an outer layer of leather is stretched over the toe area of the boot during the manufacturing process. To prevent compression of the cold insulating material (and reduction of its cold insulating properties) by the stretching of the leather during the manufacturing process, an oversized toe box is provided so that the insulating material may be secured to the inside of the toe box.

The manufacturing process of the White footwear is distinctly different. White utilizes an essentially finished footwear in which a completely pre-assembled toe cap is inserted into the toe region of the finished footwear. See, for example, col. 5, lines 13-17.

"It is believed that the present invention is the first that accomplishes insertion of a complete toe cap and lining assembly into an essentially finished footwear article of any type such as for example a molded footwear article or a machine-made shoe"

Claim 1 of the present application recites that an outer layer of leather is stretched over the oversized toe box. No such stretching occurs in the White footwear. Further, there is no

reason to believe that the toe box of White is oversized. Thus, assuming arguendo, that it would have been obvious to provide White with an outer layer of leather, the modified footwear would nevertheless not have included an outer layer of leather stretched over the oversized toe box. Accordingly, it is respectfully submitted that claims 1, 5 and 6 are patentable over White in view of WO '372.

(ii) Adams

In Adams, there is no indication that toe box 12 shown in FIGS. 1 and 3 is oversized. The drawings of Adams disclose a toe box which appears to be of conventional size and, in fact, Adams recites that metal toe protector 12 is of the type that is fairly conventional (see, col. 1, lines 64-68).

Further, there would not have been any motivation to make the Adams boot of leather, as proposed by the Examiner, to aid in protecting the user's foot from impacts. There would not have been any such motivation to modify Adams because the wearer's foot was already fully protected from impact as a result of metatarsal guard 13 and toe protector element 12. As Adams recites at column 3, lines 19-30,

“Referring again to **FIG. 2**, should a heavy weight fall from above on the foot portion of the boot, the impact force will be mainly applied to the central section **28** of guard **13** and transmitted down the sides to be distributed and absorbed at the sole. Under severe impact which might temporarily slightly deform the central section **28** the force is either not passed on to the wearer's foot or is cushioned by layer **23**. The guard **13**, even under very heavy impact loads, will strongly resist any change in its shape or position, and the sides **27** and **28** will not tend to spread outwardly under impact or crushing so that the wearer's foot is fully protected.”

Thus, the substitution of a leather outer layer would not have added any impact

protection to the already protected Adams boot. Accordingly, it is respectfully submitted that claims 1, 5 and 6 are patentable over Adams in view of WO '372.

D. Claim 7 stands rejected under 35 U.S.C. 103(a) as being obvious over any of the references applied to claim 1. For the same reasons discussed above as to why the references applied to claim 1 do not anticipate or render claim 1 unpatentable, these references likewise do not render claim 7 unpatentable.

In view of the foregoing, it is submitted that claims 1 and 5-7 are patentable over the cited prior art, either singly or in combination.

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Respectfully submitted,



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